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Supreme Court of the United States

OCTOBER TERM, A. D. 1944.

No. 382

SELCHOW & RIGHTER COMPANY,
Petitioner,

vs.

WESTERN PRINTING & LITHOGRAPHING COMPANY and WHITMAN PUBLISHING COMPANY,
Respondents.

PETITION OF SELCHOW & RIGHTER COMPANY FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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SELCHOW & RIGHTER COMPANY,
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PETITION OF SELCHOW & RIGHTER COMPANY FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Selchow & Righter Company,* respect-

* Petitioner is sometimes referred to herein as plaintiff and respondents as defendants.

fully prays for a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit to review the judgment of that Court entered on the 25th day of May, 1944 (R. Vol. II, p. 827), in a case numbered and entitled on its docket No. 8277, Selchow & Righter Company, Plaintiff-Appellant, vs. Western Printing & Lithographing Company and Whitman Publishing Company, Defendants-Appellees, affirming the decision of the United States District Court for the Eastern District of Wisconsin.

A petition for rehearing was duly presented to the Circuit Court of Appeals, and was denied on June 20, 1944 (R. Vol. II, p. 828).

A certified transcript of the record in this case, including the proceedings in the Circuit Court of Appeals, is filed herewith.

Summary Statement of Matter Involved.

Plaintiff-petitioner, Selchow & Righter Company, a New York corporation, brought this suit in the District Court for the Eastern District of Wisconsin against defendants-respondents Western Printing & Lithographing Company and the latter's wholly owned subsidiary, Whitman Publishing Company, both Wisconsin corporations. The complaint charged that the defendants, by the manufacture and sale of board and counter game sets bearing the name "Parchesi" for the playing of a pursuit game resembling backgammon (throughout identified as defendants' "blue game"), were infringing plaintiff's registered trade-mark "Parcheesi," No. 123,033 (R. Vol. I, pp. 7-11), which the plaintiff and its predecessors had applied to essentially identical paraphernalia for over seventy years; and that

the same acts constituted both an invasion of plaintiff's common law rights in its trade-mark "Parcheesi," and unfair competition (R. Vol. I, pp. 2-6). Defendants began to market their "blue game" sets bearing the notation "Parchesi" in 1939; previously they had marketed essentially identical game sets under the notation "India".

Subsequently, plaintiff filed a supplemental complaint (R. Vol. I, pp. 19-20) containing like charges based upon the expressed intention of the defendants to manufacture and sell the same paraphernalia (throughout identified as defendants' "red game") bearing the name "Pachisi" instead of "Parchesi."

Defendants' so-called "blue game" is exemplified by Exhibit 3 (R. Vol. I, p. 15); its "red game" by Exhibit 4 (R. Vol. I, p. 21).

The District Court granted a temporary injunction in favor of plaintiff (29 F. Supp. 569); and that ruling was affirmed by the court below (112 F. (2d) 430). After final hearing, however, the District Court vacated the temporary injunction (R. Vol. II, p. 787) on the ground that the defendants had discontinued the use of the name "Parchesi," and had indicated they had no intention of using that name in the future (47 F. Supp. 322, 327; R. Vol. II, p. 775). The District Court also entered judgment dismissing the complaint and supplemental complaint (R. Vol. II, p. 787). The reasons for the decision appear in the following extracts from the opinion of the District Court (47 F. Supp. 322, 323, 324, 326; R. Vol. II, pp. 768, 770, 773):

> "* * * Since 1869 plaintiff and its predecessors have used the name 'Parcheesi' as a trade-mark on board and counter games manufactured and sold in interstate commerce. * * *

> "For many years prior to 1869 a game similar to plaintiff's 'Parcheesi' was played in India. The highest count that could be made in the Indian game was twenty-five, and the Hindustani or Hindi word for 'twenty-five' sounded very similar to 'Patcheesi,' 'Parcheesi,' or 'Pachisi.' In fact, the game in India has come to be known as 'Pachisi' and is often referred to as the national game of India."
>
> * * * * * *
>
> "The testimony in the case at bar establishes that the correct spelling of the Indian name is 'Pachisi.' While it is true that this is the Indian word for 'twenty-five,' it is also the name of the Indian game which is similar to plaintiff's game of 'Parcheesi' as well as to the defendant's proposed game. * * *"

Thereupon the District Court applied the same rule that had been laid down in 1904 by the United States Circuit Court for the Southern District of New York in a case involving the same trade-mark "Parcheesi," and wherein predecessors in title of the petitioner were plaintiffs. That case was *Selchow et al.* v. *Chaffee & Selchow Mfg. Co.*, 132 Fed. 996. There Judge Ray enjoined the defendant from using the name "Parcheesi" in connection with games not manufactured or sold by the plaintiffs; but he pointed out, at pages 999-1000 of 132 Fed.:

> "* * * It is not intended to hold that defendant may not use the Hindoostanee name of this game in putting it on the market and selling it, for that everyone has the right to do. * * *"

This limitation on the injunction was carried into the interlocutory decree entered by Judge Ray (Defendants' Exhibit 31, R. Vol. II, pp. 764, 765).

It will be brought out, however, in the brief in support of the present petition, that this early *Selchow* case is not

a presently applicable authority, for the reasons that it was decided prior to the enactment of the Trade-Mark Act of 1905, and that the plaintiff is the owner of the trade-mark "Parcheesi," duly registered under that Act.

The salient facts of record which plaintiff relies upon to show that, as matter of law, its trade-mark "Parcheesi" is not descriptive of its game sets or paraphernalia, are set out in Appendix B at the end of this brief.

Jurisdiction.

(1) The judgment was rendered in a non-jury action brought under the Trade-Mark Statutes of the United States to determine the issues of the validity and infringement of a trade-mark issued under the authority of Section 5 of the Act of 1905, U. S. Code, Title 15, Section 85, specifically under the provisions of the so-called "ten-year clause" of that Act.

(2) The statutes under which the jurisdiction of this Court is invoked are Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925 (U.S.C., Title 28, Sec. 347 (a); Section 18 of the Trade-Mark Act of 1905 (U.S.C., Title 15, Sec. 98) and R.S. § 1008, as amended by the Act of February 13, 1925 (U.S.C., Title 28, Sec. 350).

(3) The decision below was entered on May 24, 1944 (R. Vol. II, p. 827). Petition for rehearing was filed on June 9, 1944 (R. Vol. II, p. 827), and was denied on June 20, 1944 (R. Vol. II, p. 828).

Questions Presented.

(1) Is it a condition precedent to the determination whether or not there is infringement of a trade-mark, validly registered under the ten-year clause of the Trade-Mark Act of 1905 and not abandoned, that the trade-mark owner shall make an affirmative showing that the mark so registered has acquired a secondary meaning?

(2) If a mark has been registered under the ten-year clause of the Act of 1905, is there a presumption of secondary meaning attaching thereto which is rebuttable only by a showing that the registration is invalid, or that the trade-mark has been abandoned by its owner?

(3) May the local law governing trade-marks and unfair competition be resorted to in order to resolve the question whether an allegedly infringing mark is a colorable imitation of a trade-mark registered under the ten-year clause of the Act of 1905, where liability for such colorable imitation is provided by the same Act (U. S. Code, Title 15, Sec. 96)?

(4) Where a trade-mark is an *idem sonans* of a word in a foreign language, and, at the time of its adoption as a trade-mark the foreign word was unintelligible and non-descriptive to the general public, is one charged with infringement thereof entitled to assert that the mark is descriptive of the trade-marked goods when he affixes the alleged infringing mark to goods which are identical with the trade-marked goods, but which, at the most, resemble only superficially the goods (in the country of the foreign language) that constitute the basis for asserted descriptiveness of the trade-mark?

(5) If the primary significance of a word in a foreign language is a number, and that word is applied to a game

of chance (played in the country of the foreign language) because of special circumstances under which that number may fall, is that word (number) descriptive, within the meaning of Section 5 of the Trade-Mark Act of 1905, when applied as a trade-mark to game sets in the use of which,—because of the absence of those special circumstances,—that number has no significance whatsoever?

(6) Where the primary significance of a word in a foreign language is a number, and that number,—because it is the highest that can be thrown,—is used in the country of that language as the name of a game of chance, but only when the game is played with unmarked sea shells and not when the game is played with stick dice, is that word (or number) descriptive when applied as a trade-mark in the United States to a similar, but not identical game set, where the implements to be thrown, supplied as a part of the game set, are ordinary cube dice, and the number, constituting the primary meaning of that word in the foreign language, cannot be thrown with the cube dice?

(7) Is plaintiff's trade-mark "Parcheesi"—registered under the ten-year clause of the Trade-Mark Act of 1905,—infringed by defendants' use of "Pachisi" when applied to the same type of board and counter game set as that manufactured and sold by plaintiff under its trade-mark?

(8) If the answer to Question (7) be in the affirmative, would the result be altered by the facts that on defendants' game sets the name of one of the defendants is displayed prominently along with "Pachisi," and that the dress of defendants' goods, as well as the color of the label thereon, differs markedly from that of the plaintiff?

Reasons Relied on for the Allowance of the Writ.

(1) The decision of the Court of Appeals for the Seventh Circuit involves an important question touching the construction, application and scope of an Act of Congress, which has not been, but should be, settled by this Court,—namely, whether local law or federal law should be applied in resolving issues (a) of infringement of a trade-mark registered under the ten-year clause of the Act of 1905 and (b) of the character and scope of the redress available to the owner of a trade-mark so registered.

(2) In holding that the common law was to be looked to in order to determine whether plaintiff is entitled to exclude defendants from the use of the word "Pachisi,"—as embodied in their red game—the Court of Appeals rendered a decision not only in conflict with applicable decisions of this Court (*Thaddeus Davids Co.* v. *Davids,* 233 U. S. 461; *Sola Electric Co.* v. *Jefferson Electric Co.,* 317 U. S. 173), but also in conflict with its own decision in *Philco Corp.* v. *Phillips Mfg. Co.,* 7 Cir., 113 F. (2d) 663, and in conflict with the decision of the Circuit Court of Appeals for the First Circuit in *Dwinell-Wright Co.* v. *National Fruit Product Co.,* 149 F. (2d) 618.

(3) In holding valid plaintiff's registration of its trade-mark "Parcheesi" under the ten-year clause of the Act of 1905, and yet holding, in effect, that plaintiff had the burden of showing that its trade-mark so registered had acquired a secondary meaning, the Circuit Court of Appeals decided a federal question in a way that conflicts with applicable decisions of this Court (*Thaddeus Davids Co.* v. *Davids,* 233 U. S. 461).

(4) In holding, in effect, that acquisition of a secondary meaning by a trade-mark cannot be adjudged to exist

in the absence of a showing that the purchasing public knows the name of the manufacturer of the goods to which the trade-mark is affixed, the Circuit Court of Appeals applied what it deemed to be local law to the decision of a federal question, namely, the question of infringement of a federal, statutory trade-mark.

(5) In *Pecheur Lozenge Co.* v. *National Candy Co.*, 315 U. S. 666, 667, this Court said that

> "* * * Both courts below having failed to consider or apply local law, we granted certiorari, 314 U. S. 603, * * * in order to determine whether local law or federal law should have been applied in a suit for infringement of a trademark registered under the Trademark Act of 1905, 33 Stat. at L. 724, * * *."

However, this Court was prevented from determining that question because, in the later review on the merits, it was disclosed that the labels of the petitioner there had been registered, not under the Trademark Law, but under the Copyright Law.

If anything, the case at bar calls more clearly for allowance of the writ of certiorari than did the *Pecheur* case; for both courts below applied common or local law tests of unfair competition to the question of infringement of a trade-mark registered under the Act of 1905 in the face of specific tests of infringement provided in Section 16 of that Act (U. S. C., Title 15, Section 96).

(6) The holding of the court below, in effect, that an *idem sonans* of petitioner's trade-mark "Parcheesi," namely, the Hindi word "pachisi,"—the primary meaning of which is "twenty-five,"—is descriptive of petitioner's game sets, involves an important question touching the construction of Section 5 of the Trade-Mark Act of 1905, which has not been, but should be, settled by this Court.

The same holding, moreover, is in conflict with the decision of the Circuit Court of Appeals for the Second Circuit in *LeBlume Import Co.* v. *Coty*, 293 Fed. 344.

Prayer.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Seventh Circuit, to the end that this cause may be reviewed by this Court; that the judgment of the Circuit Court of Appeals be reversed; and that petitioner be granted such other and further relief as may be proper.

Respectfully submitted,

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